

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated April 26, 2005, indicated that the terminal disclaimer filed on December 22, 2004, is accepted; claims 1-8 and 10-28 are rejected under 35 U.S.C. § 103(a) over Mayle *et al.* (U.S. Patent No. 6,018,774) in view of Roberts *et al.* (U.S. Patent No. 6,295,551); claim 9 is rejected under 35 U.S.C. § 103(a) over Mayle *et al.* and Roberts *et al.* and further in view of Fredlund *et al.* (U.S. Patent No. 5,666,215); and the June 6, 2004 amendment is objected to.

With respect to the objection to Applicant's June 6th amendment, Applicant traverses. Applicant submits that the instant Specification supports the objected-to subject matter. Pursuant to 35 U.S.C. § 112, the original claims are considered part of the specification. Thus, claim language is part of the Specification. The MPEP explains that, with respect to either the claims or the disclosure, word-for-word correspondence is not a requirement for claim language. *See, e.g.*, MPEP § 2173.05(e). Applicant notes that both original claims 1 and 18 include limitations directed to "one individual who converses with the sender," and the example provided at page 6, lines 14-16, describes a "voice conversation" between a realtor and a potential buyer. Thus, the Specification provides support for the objected-to subject matter. In an effort to facilitate prosecution, Applicant has canceled claim 23 rendering the objection to "wireless telephony appliance" terminology moot. Applicant submits that the added claims are in compliance with 35 U.S.C. § 132 and requests that the objection be removed.

Applicant respectfully traverses each of the Section 103(a) rejections because the Examiner fails to present any evidence of motivation. In order to present and maintain a *prima facie* Section 103(a) rejection the Examiner must show that one skilled in the art would be led to modify the primary reference (here, the '774 reference) "in view of" certain teachings absent in the primary reference but suggested by other references (*i.e.*, the '551 reference). *See*, MPEP § 706.02(j). The Examiner, however, instead presents a convoluted rationale that fails to suggest any modification of the '774 reference "in view of" the teachings of the '551 reference. The Examiner also fails to provide any evidence

that the skilled artisan would modify the '774 teachings in view of the '551 reference. The Examiner contradicts the stated rejections (the skilled artisan would modify the '774 reference in view of the teachings of the '551 reference) by proposing to modify the '551 system to include (in view of) teachings from the '774 reference. Applicant submits that the rejections are improper and requests that they be withdrawn.

The Examiner's alleged motivation for the rejections is also improper and fails to support the stated rejection. The Examiner states at page 3 of the Office Action that "The motivation would have been to use another possible source of the shared images, in this case captured images." This alleged motivation fails to address any reason why or how the skilled artisan would combine a non-internet telephony accessible system with the '551 system, or vice versa, while providing an operable system. The Examiner cites both the '774 and '551 references as teaching about half of the claimed limitations and generally asserts in hindsight that they are combinable without providing proper rationale. Again, the stated rejection would indicate that the '551 teachings should be inserted into the '774 teachings, but no logical motivation or assertion has been made with respect to that combination.

Moreover, the proposed combination is a hypothetical embodiment that would be inoperable. According to the '551 reference, both the user computer and any second computers need an applet to establish a link and communicate with the '551 server. *See*, '551 reference at column 3, lines 38-43. As the Examiner's combination would not include any aspects of these applets which are necessary for communicating with the server and the proposed combination as described at page 3 of the Office Action would not include the '551 server, the '551 user computer would not be able to communicate with the server. The Examiner has thrown two sets of teachings together without any operable aspects of the '551 reference's communication; thus, the computer would not communicate for operability. The MPEP states that when a proposed modification renders the teachings being modified unsatisfactory for their intended purpose, there is no suggestion or motivation to make the proposed modification under 35 U.S.C. § 103(a). *See* MPEP § 2143.01. Thus, the rejections are improper.

In view of the above discussion, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

Dated: June 15, 2005

By: 

Robert J. Crawford
Reg. No. 32,122